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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,228	01/18/2002	Erich Frauendorfer	1085-019	9083

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 10/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,228

Applicant(s)

Frauendorfer et al.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the words, “showing” and “shows”, are equivalent to “having” and “has”.

Within claim 2, applicants refer to the general formula as a group; however, it is unclear if applicants are actually specifying a group (i.e., functional group) or a compound. Also, the meaning of the language, “... contain part of one or more cyclic residues ...”, is not clear; it is unclear with respect to the structures provided for by this language. It is unclear if the language provides for the linking of R groups to yield ring structures.

Within claims 2 and 8, the use of the language, “can be”, renders the claims indefinite, because it is unclear to what extent the language is a required or definitive limitation.

Within claims 2, 4, 6, and 12, the language denoted by “such as”, “in particular”, and “preferentially”, renders the claims indefinite, because it cannot be determined if or to what extent the language further limits the broad language or embodiment within the claim. This language is akin to claiming a range within a range.

Within claim 3, the clear meaning of “at least one R^1 , R^2 , and R^3 ” is uncertain. Does the use of “and” require that each of the R groups have the definition within claim 3 or does only one of the R groups have to have the definition?

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Within claim 4, it is unclear what is meant by “residue”. What groups are encompassed by the term? Furthermore, the wording of the claim is confusing, because a hydrogen atom can not perform a linking function; it should be clarified that the “residue” contains the β -hydrogen atom.

Within claim 7, it is unclear what quantity is denoted by the language, “consist mainly of ...”.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 provides for the use of the composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to define “tenside compounds”.

4. The specification is objected to, because it does not contain a brief description of the drawings with the appropriate heading.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 6-11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Richey, Jr. et al. ('336).

Patentees disclose coating compositions comprising polyols, isocyanate crosslinking agents, and an amine oxide. See abstract and columns 3-6. The position is taken that the disclosed amine oxide inherently performs a catalyst function, to the extent claimed by applicants. In view of patentees' disclosure at column 6, line 22, the position is taken that the addition of additional catalysts is optional.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nahas et al. ('799 or '265) or Linden ('000) or Dammann et al. ('083).

Patentees disclose compositions comprising polyisocyanates, active hydrogen compounds, and catalysts, wherein amine oxides are disclosed as being suitable catalysts. See column 5, lines 5-7 within Nahas et al. See column 4, line 60 within Linden. See column 10, line 64 within Dammann et al.

8. Since amine oxides were known catalysts for polyisocyanate based polymer systems at the time of invention, the position is taken that it would have been obvious to select such catalysts from the disclosures of the prior art and employ them within the instant polyisocyanate based

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reaction system. It has been held that it is *prima facie* obvious to utilize a component for its known function. *In re Linder*, 173 USPQ 356; *In re Dial et al.*, 140 USPQ 244.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

September 29, 2002